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Michael E. Caporali

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

EXAMINER

HAGEMAN, MARK

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. CAPORALI

Appeal 2009-003089
Application 10/718,362
Technology Center 3600

Decided: January 11, 2010

Before JENNIFER D. BAHR, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael E. Caporali (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the Examiner's decision rejecting claims 1-13 and 15-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We REVERSE.

THE INVENTION

Appellant's claimed invention is an insert for mail sorting. Spec. 1. Claims 1 and 9, reproduced below, are representative of the subject matter on appeal.

1. A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin; and

at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.

9. A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising at least one substantially rigid substantially vertical section projecting from a substantially horizontal section, wherein the insert is sized and configured to receive flat mail from an automatic mail sorter, and wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin.

THE EVIDENCE

The Examiner relies upon the following evidence:

Ashbrook	US 1,659,509	Feb. 14, 1928
Henig	US 3,754,646	Aug. 28, 1973
Lambert	US 3,908,821	Sep. 30, 1975
Pippin	US 6,715,614 B2	Apr. 6, 2004

THE REJECTIONS

Appellant seeks review of the following rejections:

1. The Examiner rejected claims 1, 2, 4-10, 12, 13, and 15-27 under 35 U.S.C. § 103(a) as being unpatentable over Ashbrook and Pippin.
2. The Examiner rejected claims 1-13 and 15-27 under 35 U.S.C. § 103(a) as being unpatentable over Lambert and Pippin.
3. The Examiner rejected claims 1-13 and 15-27 under 35 U.S.C. § 103(a) as being unpatentable over Henig and Pippin.

ISSUE

The Examiner found that each of Ashbrook, Lambert, and Henig disclose an insert substantially as called for in each of independent claims 1, 9, 19, and 20, except that these references do not disclose that the support is constructed such that a maximum height of the support approximates a maximum height of a mail sorting bin (claims 1 and 19) and do not disclose that the vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin (claims 9 and 20). *See e.g.*, Ans. 3-5. The Examiner found that Pippin discloses supports constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin for the purpose of maintaining sequence order and facilitating delivery and also discloses dimensioning the insert with a height of approximately 11 inches such that it fits closely within letter trays used by the U.S. Postal Service for allowing storage and use of the insert with flats tubs or letter trays. *See e.g.*, Ans. 3, 5. The Examiner concluded that it would have been obvious to modify the vertical supports of the devices of Ashbrook, Lambert, and Henig, so that the maximum height of the support

approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purpose of maintaining sequence order and facilitating delivery, and it would have been obvious to dimension the insert to have a height of approximately 11 inches such that it fits closely within letter trays used by the U.S. Postal Service for the purpose of allowing storage and use of the insert with flats tubs or letter trays. *See e.g.*, Ans. 4, 6.

Appellant contends that there is simply no motivation to use either the envelope holder of Ashbrook, the record keeping tray of Lambert, or the receptacle of Henig, with the flats tub of Pippin or to modify these prior art devices to have a support or vertical section sized as called for in claims 1, 9, 19, and 20. *See e.g.*, App. Br. 8, 22, 35.

The issue presented by this appeal is:

Has Appellant shown the Examiner erred in concluding that it would have been obvious to one having ordinary skill in the art to modify the devices of Ashbrook, Lambert, and Henig to have either supports with a maximum height that approximates a maximum height of a mail sorting bin or vertical sections with a height of approximately 11 inches in view of the teachings of Pippin?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Ashbrook discloses a device for holding envelopes, the device having channel shaped pockets 6 that are shorter than the height of

- standard envelopes so that the envelopes may readily be grasped and removed. Ashbrook 1, ll. 3-6, and ll. 24-26; fig. 1.
2. Lambert discloses a record keeping tray including a separator insert assembly for segregating and storing canceled checks according to categories. Lambert, col. 1, ll. 25-28 and ll. 33-35.
 3. Henig discloses a receptacle for use in retaining groups of letters in proper form during sorting and handling and for their subsequent removal as a group or stack ready for banding or tying. Henig, col. 1, ll. 5-7 and ll. 41-44; Henig, at col. 4, ll. 59-62. Henig's notches 7 are considerably shorter than the height of the letters held in the receptacle so that the notches 7 do not interfere with removal of the letters as a group or stack. Henig, figs. 1, 2, 2A.
 4. Pippin discloses a multi-bag storage device 30 preferably having a depth of at least twelve inches and having dimensions that permit it to fit closely within existing letter trays 50 used by the U.S. Postal Service for storage. Pippin, col. 6, ll. 10-14; col. 8, ll. 23-26; fig. 4.

PRINCIPLES OF LAW

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences

between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 406-07 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Supreme Court stated that when the claimed subject matter “involve[s] more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement,” then an explicit analysis must be provided to articulate “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 417-18. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

ANALYSIS

Claim Construction

The Examiner construed the support/vertical section size limitations of claims 1, 9, 19, and 20 as purely functional limitations, and thus determined that it “is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim.” *See e.g.*, Ans. 22-23. We disagree with the Examiner’s treatment of these limitations as purely functional. While the mail sorting bin is not positively recited in

claims 1 and 19, these claims recite that the support is “constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.” This claim language imparts a structural limitation on the height of the support, requiring it to be of a specific height that approximates the height of a mail sorting bin. Claims 9 and 20 similarly recite claim language that imparts a structural limitation on the height of the support, requiring it to be approximately 11 inches when the insert is disposed within the mail sorting bin. While we acknowledge that the dimensions of the mail sorting bin are not recited in any of the independent claims, this omission does not somehow transform these structural limitations of the claims into functional limitations.

Prior Art Rejections

For the reasons provided below, the Examiner’s stated rationales for modifying the heights of the vertical supports in the devices of Ashbrook, Lambert, and Henig to meet the claims are inadequate. The Examiner determined that it would have been obvious to modify the height of the support in Ashbrook’s envelope holder “for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.” Ans. 4 (claim 1), *See also* Ans. 5 (claim 9), Ans. 7 (claim 19), Ans. 8 (claim 20). The Examiner’s rationale, however, fails to provide an articulation of an adequate reason why a person having ordinary skill in the art would have been led to look to the teachings of Pippin so as to use the envelope holder of Ashbrook for postal mail sorting and delivery. Further, the mail sorting bin of Pippin has a maximum height of at least 12 inches. Fact 4. The channel-shaped pockets 6 of Ashbrook’s envelope holder are shorter than the height of standard

envelopes so that the envelopes can be “readily grasped and removed”. Fact 1. Modifying the vertical supports of Ashbrook’s envelope holder to make them the same height as the bin of Pippin, as called for in claims 1 and 19, or to make them approximately 11 inches, as called for in claims 9 and 20, would make the vertical supports taller than the height of standard envelopes and thus destroy the purpose of envelope holder of Ashbrook by not allowing the envelopes to be readily grasped and removed.

The Examiner determined that it would have been obvious to modify the height of the vertical supports in the record keeping tray of Lambert “for the purpose of maintaining sequence order and facilitating delivery,” Ans. 10 (claim 1) and “for the purpose of storing and using the insert with flats tubs or letter trays, Ans. 11 (claim 9). *See also* Ans. 13 (claim 19), Ans. 14 (claim 20). The Examiner’s rationale, however, fails to provide an articulation of an adequate reason why a person having ordinary skill in the art would have been led to look to the teachings of Pippin so as to use the canceled check record keeping tray of Lambert for postal mail sorting and delivery.

The Examiner determined that it would have been obvious to modify the height of the support in Henig’s receptacle “for the purpose of maintaining sequence order and facilitating delivery,” Ans. 16 (claim 1), and “for the purpose of storing and using the insert with flats tubs or letter trays,” Ans. 17 (claim 9). *See also* Ans. 20 (claims 19 and 20). Henig discloses using its receptacle to arrange and orient letters so as to be removable as a group or stack ready for banding or tying. Fact 3. As such, Henig’s notches 7 are considerably shorter than the height of the letters held in the receptacle so that the notches 7 do not interfere with removal of the letters as a group or

stack. Fact 3. We find no reason why a person having ordinary skill in the art would have been led to increase the height of the notches 7 of Henig to be 11 or 12 inches tall, since a notch of such height would create a divider between each letter that is taller than the height of the letter and would thus destroy the intended use of Henig's receptacle. Further, the Examiner's rationale fails to provide an articulation of an adequate reason why a person having ordinary skill in the art would have been led to look to the teachings of Pippin so as to adapt the receptacle of Henig so that it would match the height of a mail sorting bin used for postal mail sorting and delivery.

CONCLUSION

Appellant has shown the Examiner erred in concluding that it would have been obvious to one having ordinary skill in the art to modify the devices of Ashbrook, Lambert, and Henig to have either supports with a maximum height that approximates a maximum height of a mail sorting bin or vertical sections with a height of approximately 11 inches in view of the teachings of Pippin.

DECISION

The decision of the Examiner to reject claims 1-13 and 15-27 is
REVERSED.

REVERSED

Appeal 2009-003089
Application 10/718,362

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206